

REMARKS

This paper is filed in response to the final office action dated January 11, 2008. This paper is timely-filed as it is accompanied by a petition for an extension of time to file in the first month and authorization to charge our credit card in the amount of the requisite extension fee.

Claims 1-29 are pending. Claims 1, 10, 19, 21, and 23 have been amended without prejudice or disclaimer to recite “titanium dioxide in an amount from about 35 weight percent to about 60 weight percent.” Support for the amendment may be found, for example, at page 5, lines 13-14. No new matter has been added.

The applicants respectfully submit that the accompanying amendments are proper under 37 C.F.R. § 1.116 practice and should be entered because the rejections set forth in the final office action have been overcome. Moreover, these amendments should be entered because they do not present new issues requiring further consideration or search – for example, because the amended claims are allowable over the cited art for at least the reasons the examiner indicated that claims 25-29 are allowable, as explained in more detail below.

Claims 1-6, 10, 12-15, and 19-24 have been rejected under 35 U.S.C. § 103(a) as obvious over European Patent Publication No. 0 549 145 to Fasano (“Fasano EP”). Claims 7 and 16 have been rejected under 35 U.S.C. § 103(a) as obvious over Fasano EP in view of U.S. Patent No. 5,236,987 to Arendt (“Arendt”). Claims 8, 9, 17, and 18 have been rejected under 35 U.S.C. § 103(a) as obvious over Fasano EP in view of either U.S. Patent No. 4,243,417 to Grouke (“Grouke”) or U.S. Patent No. 4,283,320 to Carroll (“Carroll”). Claim 11 has been rejected under 35 U.S.C. § 103(a) as obvious over Fasano EP in view of U.S. Patent No. 5,418,013 to Detrick (“Detrick”).

Additionally, claims 1-6, 10-15, 23, and 24 have been rejected under 35 U.S.C. § 103(a) as obvious over Detrick in view of U.S. Patent Publication No. 2002/0103283 to Elfring (“Elfring”). Claims 7 and 16 have been rejected under 35 U.S.C. § 103(a) as obvious over the combination of Detrick and Elfring further in view of U.S. Patent Publication No. 2002/0151648 to Fasano (“Fasano US”). Finally, claims 8, 9, 17, and 18 have been rejected under 35 U.S.C. § 103(a) as obvious over the combination of Detrick and Elfring further in view of U.S. Patent No. 4,032,491 to Schoenke (“Schoenke”).

CLAIM REJECTIONS

All pending claims 1-24 have been rejected as variously obvious over Fasano EP alone or in further view of Arendt, Grouke, Carroll or Detrick. Additionally, claims 1-18, 23, and 24 have been rejected as variously obvious over the combination of Detrick and Elfring by itself or in further view of Fasano US or Schoenke. The applicants respectfully traverse the rejections as applied to the claims presented herein for at least the reasons articulated in their previous responses and further submit that the accompanying amendments should be entered, and the application allowed, for at least the following reasons.

The examiner previously recognized that the color changing fluids containing titanium dioxide in an amount from 35 weight percent to about 50 weight percent, as claimed, and methods for correcting an error on a substrate with such fluids are allowable over the cited art. Extending the aforementioned range to 60 weight percent, in accordance with the teachings of the application, does not raise new issues or require further consideration as the examiner's basis for rejecting the previously pending claims was based upon art assertedly disclosing compositions containing titanium dioxide "up to and including 20 weight percent." *See* final action at page 3. Accordingly, the amended claims are allowable for the same reasons the examiner indicated claims 25-29 as allowable.

Additionally, the applicants respectfully submit that they had possession of the amended range because one of ordinary skill in the art would recognize that the original specification is sufficient to demonstrate their possession of the newly recited range.

Statutory law requires that the specification shall contain a written description of the invention. *See* 35 U.S.C. § 112, first paragraph. The courts have interpreted that provision as requiring that the description of the invention be sufficient to allow one of skill in the art to recognize that Applicant was in possession of the subject matter claimed. *Vas-Cath v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991); *accord*, M.P.E.P. §2163 (I). Possession is shown by describing the claimed invention with all of its limitations using descriptive means such as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *See, e.g.*, M.P.E.P. §2163 (I).

Here, page 5 lines 13-14 explicitly demonstrates applicants' possession of compositions comprising titanium dioxide in an amount from about 20 weight percent to about 60 weight percent and also from about 35 weight percent to about 50 weight percent. The applicants submit that their possession of the endpoints (i) 35 weight percent and (ii) 60 weight percent clearly demonstrates their possession of the newly recited range. Accordingly, the accompanying amendments should be entered and this case should be allowed.

CONCLUSION

It is submitted that the application is in condition for allowance. Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, he is respectfully invited to contact the undersigned attorney at the indicated telephone number.

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Respectfully submitted,



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